

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES K. BASHKIN, MICHAEL K. STERN
and ANIL S. MODAK

Appeal No. 1995-1304
Application No. 07/947,071¹

ON BRIEF

Before WINTERS, WILLIAM F. SMITH and LORIN, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed September 16, 1992. According to appellants, this application is a continuation of Application No. 07/550,001, filed June 14, 1990, now abandoned.

Appeal No. 1995-1304
Application No. 07/947,071

This appeal was taken from the examiner's decision rejecting claims 1, 3 through 8, 10 through 16, 20 through 23, and 25 through 30. Claims 31 through 33, which are the only other claims remaining in the application, stand allowed.

REPRESENTATIVE CLAIM

Claim 1, which is illustrative of the subject matter on appeal, reads as follows:

1. The method of hydrolytically cleaving RNA under physiologically relevant conditions with a compound selected from the group consisting of nucleosides, nucleotides and oligodeoxy-nucleotides having attached thereto a metal complex effective for RNA hydrolysis.

THE REJECTIONS

In rejecting the appealed claims on non-prior art grounds, the examiner does not rely on any references.

The claims stand rejected as follows: (1) claims 1, 3 through 8, 10 through 16, 20 through 23, and 25 through 30 under 35 U.S.C. § 112, first paragraph, "as being based on an insufficient disclosure to support the scope of the claimed subject matter"; and (2) claims 1, 3 through 8, 10 through 16, 20 through 23, and 25 through 30 under 35 U.S.C. § 112, first

Appeal No. 1995-1304
Application No. 07/947,071

and second paragraphs, "as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." See the Examiner's Answer, pages 3 and 9.

Appeal No. 1995-1304
Application No. 07/947,071

DISCUSSION

The examiner argues that appellants' specification is insufficient to support the scope of claims 1, 3 through 8, 10 through 16, 20 through 23, and 25 through 30. According to the examiner, the specification does not provide adequate guidance enabling any person skilled in the art to make compounds which hydrolytically cleave RNA except for the compounds enumerated in allowed claims 31 through 33. We disagree.

As stated in In re Armbruster, 512 F.2d 676, 677-78, 185 USPQ 152, 153 (CCPA 1975) quoting from In re Marzocchi, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971):

As a matter of Patent Office practice, then, a specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as in compliance with the enabling requirement of the first paragraph of § 112 unless there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. . . .

. . . [I]t is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or

Appeal No. 1995-1304
Application No. 07/947,071

reasoning which is inconsistent with the contested statement.

Having carefully reviewed the Answer (Paper No. 26), we find that the examiner has not provided adequate reasons or evidence which

Appeal No. 1995-1304
Application No. 07/947,071

would cast doubt on the objective truth of statements contained in the specification and relied on for enabling support. We believe that appellants' specification (including EXAMPLES I through XV) imparts ample information to persons skilled in the art, enabling them to make and use the full scope of the claimed subject matter.

Referring to page 13, TABLE 1 of the specification, the examiner argues that "some compounds work, some do not"; and, for this reason, the specification is inadequate to support the full scope of the appealed claims. See the Examiner's Answer, page 4. However, as stated in a similar context in Atlas Powder Co. v. E.I. Du Pont De Nemours and Co., 750 F.2d 1569, 1576-77, 224 USPQ 409, 414 (Fed. Cir. 1984):

Even if some of the claimed combinations were inoperative, the claims are not necessarily invalid. "It is not a function of the claims to specifically exclude . . . possible inoperative substances. . . ." Of course, if the number of inoperative combinations becomes significant, and in effect forces one of ordinary skill in the art to experiment unduly in order to practice the claimed invention, the claims might indeed be invalid. . . . That, however, has not been shown to be the case here. [Citations omitted.]

On this record, the examiner has not established that the number of inoperative compounds encompassed by the claims is

Appeal No. 1995-1304
Application No. 07/947,071

significant or "in effect forces one of ordinary skill in the art to experiment unduly in order to practice the claimed invention."

The rejection of claims 1, 3 through 8, 10 through 16, 20 through 23, and 25 through 30 under 35 U.S.C. § 112, first paragraph, "as being based on an insufficient disclosure to support the scope of the claimed subject matter" is reversed.

Claims 1, 3 through 8, 10 through 16, 20 through 23, and 25 through 30 also stand rejected under 35 U.S.C. § 112, first and second paragraphs, "as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." See the Examiner's Answer, page 9. According to the examiner, these claims are indefinite and based on a non-enabling disclosure in view of the recitation "physiologically relevant conditions."

The rejection is manifestly untenable with respect to claims 8, 10 through 16, and 20 through 22, because these claims do not recite "physiologically relevant conditions."

Appeal No. 1995-1304
Application No. 07/947,071

Claims 1, 3 through 7, 23, and 25 through 30 stand on different footing. It would appear, on the surface, that the claim language "physiologically relevant conditions" refers to 7.1 pH and 37EC. This follows from reading the claims in light of the specification, page 10, lines 22 and 23. There, the specification describes "physiologically relevant conditions (7.1 pH and 37EC)." Looking under the surface, however, we note appellants' statement in the Appeal Brief, page 3, lines 4 and 5, that dependent claim 30 limits the "physiologically relevant conditions" to pH and temperature. This means to say that claims 1, 3 through 7, 23, and 25 through 30 are not limited to 7.1 pH and 37EC. In other words, the case before us presents an ambiguity. Reading the claims in light of the specification suggests that the expression "physiologically relevant conditions" is limited to 7.1 pH and 37EC; whereas reading the claims in light of each other suggests that the expression "physiologically relevant conditions" is not so limited. On these facts, we agree with the examiner that claims 1, 3 through 7, 23, and 25 through 30 are unclear and indefinite.

Appeal No. 1995-1304
Application No. 07/947,071

The situation is aggravated because claim 30, which depends from claim 1, requires that the physiologically relevant conditions be "selected from pH and temperature." It is unclear from this usage whether appellants mean pH or temperature in the alternative, or a combination of both pH and temperature (for example, 7.1 pH and 37°C).

In the Appeal Brief, pages 4 and 5, appellants state that:

The phrase "in physiologically relevant conditions" refers to physical conditions which are known or can be readily determined by an ordinarily skilled artisan. Although these conditions may not exclude a method involving physiological activity, the relevant physiological conditions are themselves readily available to or can be determined by an ordinary artisan. A reference to exemplify such conditions is made of record in the prosecution giving a specific enabling source for the scope of the claims. Other such sources are available for enabling this invention. In other words, the conditions are not variable, and the only variability is from one set of conditions to another and the source of information regarding such conditions. Even for undocumented conditions there is no variability of the conditions from time to time and each new set of conditions can be readily determined.

. . . [T]he "physiologically relevant conditions" are not vague in that these conditions are the same and definite for a given subset. That is, as noted by [the] Examiner, differences are relevant from a plant, to a spider, to a cyanobacterium, or to a human but within each of these there are no such

Appeal No. 1995-1304
Application No. 07/947,071

differences as shown by the reference exemplifying such conditions noted above. Here definiteness is evident for a given physiological set of conditions. For those conditions not readily found in references, an ordinarily skilled artisan can make a definite determination of the actual conditions of various physiologies with virtually no experimentation given the technology available today to measure temperature and pH.

We have carefully reviewed and reflected on the above-quoted statement, but are at a loss to understand just what appellants mean by the expression "physiologically relevant conditions."

The rejection of claims 1, 3 through 7, 23, and 25 through 30 under 35 U.S.C. § 112, second paragraph, as indefinite in view of the expression "physiologically relevant conditions" is affirmed. We shall not pass on the rejection of claims 1, 3 through 7, 23, and 25 through 30 under 35 U.S.C. § 112, first paragraph, as based on a non-enabling disclosure in view of the expression "physiologically relevant conditions." Where, as here, the scope of the claims is unclear, we cannot engage in a meaningful analysis under 35 U.S.C. § 112, first paragraph. Cf. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971) (Claims must be analyzed first to determine exactly what subject matter they

Appeal No. 1995-1304
Application No. 07/947,071

encompass before considering the written description requirement of 35 U.S.C. § 112, first paragraph.)

CONCLUSION

In conclusion, the rejection of claims 1, 3 through 8, 10 through 16, 20 through 23, and 25 through 30 under 35 U.S.C. § 112, first paragraph, "as being based on an insufficient disclosure to support the scope of the claimed subject matter" is reversed.

The rejection of the appealed claims as indefinite and based on a non-enabling disclosure in view of the recitation "physiologically relevant conditions" is reversed with respect to claims 8, 10 through 16, and 20 through 22.

The rejection of claims 1, 3 through 7, 23, and 25 through 30 under 35 U.S.C. § 112, second paragraph, as indefinite in view of the expression "physiologically relevant conditions" is affirmed. We do not reach the rejection of claims 1, 3 through 7, 23, and 25 through 30 under 35 U.S.C. § 112, first paragraph, as based on a non-enabling disclosure in view of the expression "physiologically relevant conditions."

Appeal No. 1995-1304
Application No. 07/947,071

The examiner's decision is affirmed-in-part.

Appeal No. 1995-1304
Application No. 07/947,071

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

SHERMAN D. WINTERS)	
Administrative Patent Judge)	
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WILLIAM F. SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
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Appeal No. 1995-1304
Application No. 07/947,071

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